REMARKS

By the above amendment, the independent claims of this application, i.e., claims 5, 6 and 16 have been amended to additionally recite the feature, as described at page 8, lines 2 - 11 of the specification in relation to Fig. 6 of the drawings of this application, for example, that the outputted actual image of an extracted defect candidate and data comprising the location of the defect candidate is stored, such as in a memory, as represented by the server 151, as illustrated in Fig. 6. Thus, as now recited in the independent claims, the outputted actual image of the defect candidate and data comprising the location of the defect candidate is stored, and the actual image of the defect candidate, which is selected to be displayed, is selected from the stored actual images of the defect candidates, and is displayed on a display screen together with the location data in a map format on the same screen, in the manner as described in connection with Figs. 6 and 8 of the drawings of this application. Applicants submit that such features are not disclosed or taught in the cited art.

The rejection of claims 3, 5 - 6, 12 - 16 and 25 - 30 under 35 USC 103(a) as obvious over US Patent No. 6,047,083 issued to Mizuno and US Patent No. 6,097,887 issued to Hardikar et al, and the rejection of claims 10 - 11 and 20 - 24 under 35 USC 103(a) as being unpatentable over Mizuno and Hardikar et al further in view of US Patent No. 6,539,106 issued to Gallarda et al, such rejections are traversed insofar as they are applicable to the present claims and reconsideration and withdrawal of the rejections are respectfully requested.

As to the requirements to support a rejection under 35 USC 103, reference is made to the decision of In re Fine, 5 USPQ 2d 1596 (Fed. Cir. 1988), wherein the

court pointed out that the PTO has the burden under '103 to establish a prima facie case of obviousness and can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. As noted by the court, whether a particular combination might be "obvious to try" is not a legitimate test of patentability and obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. As further noted by the court, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

Furthermore, such requirements have been clarified in the decision of In re Lee, 61 USPQ 2d 1430 (Fed. Cir. 2002) wherein the court in reversing an obviousness rejection indicated that deficiencies of the cited references cannot be remedied with conclusions about what is "basic knowledge" or "common knowledge". The court pointed out:

> The Examiner's conclusory statements that "the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software" and that "another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial" do not adequately address the issue of motivation to combine. This factual question of motivation is immaterial to patentability, and could not be resolved on subjected belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher."... Thus, the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the

reasoning by which the findings are deemed to support the agency's conclusion. (emphasis added)

Irrespective of the examiner's contentions concerning Mizuno and Hardikar et al, applicants submit that Mizuno and Hardikar et al provide no disclosure or teaching concerning storing outputted actual image of the defect candidates, displaying an actual image of a defect on a screen by selecting from the actual images stored in a memory. As described in column 4, lines 20 - 40 of Mizuno, an alignment process is performed by comparing an optical microscopic image of the alignment pattern formed on the wafer 5 with a reference image so as to display a wafer map "a map of points to be inspected". As described in column 4, line 41 to column 5, line 51 of Mizuno, after the wafer map has been displayed, the operator specifies the point on the map to be inspected, and the stage moves so that the specified point which is to be inspected, is inspected, by irradiation and scanning of an electron beam. Applicants submit that Mizuno provides no disclosure or teaching of storing the detected defect candidate actual images in the memory and displaying a defect candidate actual image selected from the actual images stored in the memory by designating the defect candidate from the map format which is displayed on the display screen so that both the map format of defect candidates and the actual image of the selected defect candidate are simultaneously displayed on the same display screen. In this regard, while the Examiner refers to column 6, lines 32 - 44 of Mizuno, with regard to an image of the defect candidate being displayed on a screen, it is noted that column 6, lines 32 - 44 refer to Figs. 3 - 5 of the drawings of Mizuno, wherein recorded or stored reference images are used for alignment, positioning and defect detecting, in the manner set forth. More importantly, the results of the operation of Fig. 3 is obtained in step 15, which output results of

inspection/results of calculation, in the manner illustrated in Fig. 6B of Mizuno, wherein indicia in accordance with the table, as shown in the right-hand side of Fig. 6B, are displayed in the map format, as shown in the left-hand side of Fig. 6B. Thus, it is readily apparent that Mizuno does not disclose or teach in the sense of 35 USC 103 the recited features of the independent and dependent claims of this application and all claims patentably distinguish thereover.

The Examiner, apparently recognizing the deficiency of Mizuno, at least in relation to the simultaneous display on one screen of a map format at one portion of the screen and an actual image of the defect candidate at another portion of the screen, refers to column 6, lines 8 - 36 of Hardikar et al and Fig. 6C thereof for such feature. Irrespective of the Examiner's contentions, none of the figures of Hardikar et al disclose or teach the recited features wherein Fig. 4A and Fig. 6C of Hardikar et al merely illustrate the simultaneous display of a map format and other information, which other information is not an actual image of the selected defect candidate, which is stored in a memory. Thus, applicants submit that the combination of Mizuno and Hardikar et al fail to provide the claimed features as recited in the claims of this application in the sense of 35 USC 103 and all claims should be considered allowable thereover.

Applicants note that the Examiner's approach appears to that it would be obvious to provide the claimed features. However, "obvious to try" is not the standard of 35 USC 103. See In re Fine, supra. Furthermore, since there is no disclosure in either Mizuno or Hardikar et al of the recited features as now set forth in the independent and dependent claims of this application, it appears that the Examiner's approach appears to come about from review of applicants' disclosure.

Hereagain, this approach where the Examiner utilizes what applicant has taught against the teacher in rejecting the claims is not proper. See In re Lee, supra. Thus, applicants submit that all claims patenetably distinguish over this proposed combination of references in the sense of 35 USC 103 and all claims should be considered allowable thereover.

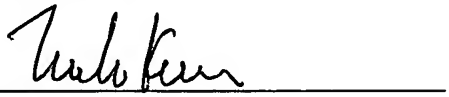
As to the further combination of Gallarda et al with Mizuno and Hardikar et al, applicants submit that whether or not Gallarda et al discloses defect candidate location data being displayed in map format on a screen, Gallarda also fails to disclose the storage of actual images of defect candidates in a memory and displaying the actual image of a defect candidate selected from the memory simultaneously with a display of the defect candidates in map format. Thus, this combination also fails to disclose or teach the claimed features in the sense of 35 USC 103 and all claims should be considered allowable over this proposed combination of references.

In view of the above amendments and remarks, applicants submit that all claims present in this application patentably distinguish over the cited art and should now be in condition for allowance. Accordingly, issuance of an action of a favorable nature is courteously solicited.

To the extent necessary, applicant's petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing

of this paper, including extension of time fees, to Deposit Account No. 01-2135 (501.41125X00) and please credit any excess fees to such deposit account.

Respectfully submitted,



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